

### **REMARKS**

The Nonfinal Office Action of September 1, 2009 has been carefully reviewed and this paper is responsive thereto. Claims 30-65 are pending in this application. Claims 30, 32-34, 37-47, 52, 53-55, 60 and 61 have been amended and claims 31, 48-51, 53, 59 and 63-65 have been canceled. No new matter has been added to the application.

### **Allowable Subject Matter**

The Applicants would like to express appreciation at the indication that claims 31-34, 39-47, 53-55 and 60-62 would be allowable if rewritten to overcome the rejections under 35 U.S.C. § 112, second paragraph and to include all of the limitations of the base claim and any intervening claims. By this response, the features of claim 31 have been included in independent claim 30 and the features of claim 53 have been included in independent claim 52, and claims 31 and 53 have been canceled. Consequently, amended independent claims 30 and 52 are allowable. Claims 31-47, 56-58 and 60-62 depend from claim 30, and claims 54-55 depend from claim 52 and are allowable for at least the same reasons as amended claims 30 and 52, respectively, and for the additional features recited therein.

### **Election/Restriction**

In the Office Action, claims 30-65 were deemed subject to a restriction and/or election requirement and made final. More specifically, an election was required between the following:

Group I: Claims 30-47 and 52-62, drawn to a method of decoration the walls of cylindrical containers by a transfer film.

Group II: Claims 48-51, 59 and 63-65, drawn to a device of decorating the walls of cylindrical containers.

By this response, the Applicants, without prejudice or admission, cancel Group II, claims 48-51, 59 and 63-65.

### **Claim Objections**

Claims 30 and 53 were objected to for informalities. Claim 30 was objected to for use of the term “transferable” in line 19 and claim 53 was objected to for the phrase “the cylindrical container wall.” As required by the Office Action, claim 30 has been amended to replace “transferable” with “transfer”. As noted above, the features of claim 53 have been included in claim 52 and to delete “container”. Accordingly, the Applicants respectfully request withdrawal of the claim objections.

### **Claim Rejections – 35 U.S.C. § 112**

Claims 30-65 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The Office Action states the following on page 3: “Claims 30 and 52 disclose “a transfer film bearing strip”; however the dependent claims refer to “the transfer film” and “the bearing strip”. One phrase should be chosen to maintain consistency throughout the claims to properly understand the claimed inventions.”

The Applicants respectfully submit that although “the bearing strip” may be referred to as “the transfer film bearing strip”, “the transfer film” is a separate entity and to refer to it as the “transfer film bearing strip” would be inaccurate. The reason for this is that the transfer film bearing strip is a two-part component: a bearing strip and a transfer film disposed on the bearing strip. Paragraph [20] of the application as originally filed discloses that when the transfer film bearing strip is moved away from the surface of the container, “the part of the transfer film remaining bonded to the container wall is detached from the bearing strip, thus bringing about the decoration.” Accordingly, “the transfer film bearing strip” and “the transfer film” are in fact different components and require distinction to properly understand the claimed inventions.

By this response, each occurrence of the phrase “the bearing strip” in claims 30, 32, 34, 41-45, 52, 60-61 and 64 has been amended to instead recite “the transfer film bearing strip”, for consistency, rendering the rejection moot.

Claim 30 was rejected for having insufficient antecedent basis for the limitation “the container unit” in line 24. Claim 30 has been amended to delete the term “unit” and instead recite, in part, “the mandrel covered with the container”. This phrase has antecedent basis in line 14 of claim 30, rendering the rejection moot.

Claim 37 was rejected for having insufficient antecedent basis for the limitation “the marking area” in line 2. Claim 37 has been amended to delete the phrase “it reaches the marking area” and replace it with the phrase “being brought into contact with the impression roll”. This feature is supported at least by claim 30, line 16, which states “bringing the mandrel and the impression roll into contact with each other”, rendering the rejection moot.

Claim 39 was rejected for having insufficient antecedent basis for the limitation “the contact generatrix line” in line 3. Claim 39 has been amended to delete the phrase “the contact” and instead recite “a generatrix line of the container wall”. This amendment is supported at least by paragraph [0036] of the specification as originally filed, which discloses “contact is able to be established gradually on a generatrix line of the container wall”, rendering the rejection moot.

Claim 40 was rejected for having insufficient antecedent basis for the limitation “the cylindrical body” in line 1. Claim 40 has been amended to instead recite “the container comprises a cylindrical body being a flexible tube”. This amendment is supported at least by paragraphs [0027] and [0049] of the specification as originally filed. Paragraph [0027] states that “[t]he containers are brought in succession flush with a mandrel, typically using spikes mounted on a transfer line, then fitted onto the mandrels over a length appropriate to the decoration to be printed. For example, when flexible tubes are involved, the fitting is carried out preferably until the inside of the head comes to a stop against the head of the mandrel, which gives an axial indexing of the decoration on the tube skirt. Paragraph [0049] discloses “the decoration of cylindrical bodies, typically the cylindrical skirts of flexible tubes”. Accordingly, the container may comprise a cylindrical body being a flexible tube, rendering the rejection moot.

Claim 47 was rejected for having insufficient antecedent basis for the limitation “the device” in line 1. In addition, claims 30, 31, 46 and 47 are alleged to not disclose a “first optical device” complemented with the “second optical device”. Claim 46 has been amended to recite, in part, “an optical determination is made of a pre-marked index on the container using an optical tracking device”. Further, claim 47 has been amended to now recite, in part, “the optical

tracking device”. These amendments are supported at least by paragraph [0046] of the specification as originally filed. Paragraph [0046] discloses “the optical tracking device mentioned above is advantageously complemented by a second optical device”, thus rendering the rejection moot.

Claim 52 was rejected for having insufficient antecedent basis for the limitation “the container unit” in line 32. Claim 52 has been amended to delete the term “unit” and instead recite, in part, “the mandrel covered with the container”. This phrase has antecedent basis in line 13 of claim 52, rendering the rejection moot.

Claim 55 was rejected for having insufficient antecedent basis for the limitation “the sleeve” in line 2. Claim 55 has been amended to delete the term “sleeve” and replace it with “container wall”. This amendment is supported at least by paragraph [0080] of the specification as originally filed, which discloses that “the contact translates into a force exerted by the impression roll on the mandrel through the transfer film bearing strip and the cylindrical container wall.” Consequently, the rejection is rendered moot and the 35 U.S.C. § 112, second paragraph rejections are respectfully requested to be withdrawn.

#### **Claim Rejections – 35 U.S.C. § 102**

Claims 30, 35, 36, 37, 38 and 56 were rejected as being unpatentable over U.S. Patent No. 6,531,018 to Fiwek (“Fiwek”). Claims 35, 36, 37, 38 and 56 depend from independent claim 30. As noted above, claim 30 has been amended to include the features of claim 31, which were indicated to be allowable subject matter. Consequently, amended claim 30 is allowable over Fiwek. Claims 31-47, 56-58 and 60-62 depend from claim 30 and are patentable for at least the same reasons as amended claim 30 and for the additional features recited therein.

#### **Claim Rejections – 35 U.S.C. § 103**

Claims 52 and 56 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Fiwek in view of U.S. Patent No. 4,175,993 to Robertson et al. (“Robertson”) and U.S. Patent No. 5,464,495 to Eder (“Eder”). Claim 56 depends from claim 30. As discussed above, independent claims 30 and 52 have been amended to include the features of 31 and 53,

respectively, which were indicated to be allowable subject matter. Accordingly, amended claims 30 and 52 are patentable over Fiwek in view of Robertson and Eder. Claim 56 is patentable for at least the same reasons as amended claim 30 and for the additional features recited therein.

Claim 57 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Fiwek in view of Robertson and Eder as applied to claim 56 above, and U.S. Patent No. 6,098,689 to Fiwek ("Fiwek '689"). Claim 57 ultimately depends from claim 30. As noted above, claim 30 has been amended to include the features of claim 31, which were indicated to be allowable subject matter. Consequently, amended claim 30 is allowable over in view of Robertson, Eder and Fiwek '689. Claim 57 is patentable for at least the same reasons as amended claim 30 and for the additional features recited therein.

Claim 58 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Fiwek in as applied to claim 30 above, and further in view of Eder. Claim 58 depends from claim 30. As noted above, claim 30 has been amended to include the features of claim 31, which were indicated to be allowable subject matter. Consequently, amended claim 30 is allowable over Fiwek in view of Eder. Claim 58 patentable for at least the same reasons as amended claim 30 and for the additional features recited therein.

### **CONCLUSION**

The Applicant respectfully requests consideration of the application and allowance of all pending claims. Please feel free to contact the undersigned should any questions arise with respect to this case that may be addressed by telephone.

Respectfully submitted,  
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